

### **REMARKS**

This is in full and timely response to the Office Action mailed on September 2, 2004. Reexamination in light of the following remarks is respectfully requested.

Claims 1, 3-4 and 6 are currently pending in this application, with claim 1 being independent. *No new matter has been added.*

#### **Entry of amendment**

This amendment prima facie places the case in condition for allowance. Alternatively, it places this case in better condition for appeal. Accordingly, entry of this amendment is respectfully requested.

#### **Prematureness**

Applicant, seeking review of the prematureness of the final rejection within the Final Office Action, respectfully requests reconsideration of the finality of the Office Action for the reasons set forth hereinbelow. See M.P.E.P. §706.07(c).

#### **Independent claim 1**

Claim 1 is drawn to a pneumatic tire comprising,

a mark portion of a wear indicator which changes as wear progresses, said mark portion being provided on a portion of a tread surface of said tire and disposed apart and in isolation from a main groove extending circumferentially about said tire,

wherein said mark portion includes a first cavity and a second cavity abutting the first cavity, each one of the first and second cavities extending into a depth direction of the tread surface, and

wherein said first cavity has a first surface shape defining a first surface area that continuously changes as a depth of the tread surface decreases due to wear and said

second cavity has a second surface shape defining a second surface area that remains constant as the depth of the tread surface decreases due to wear.

**Rejection under 35 U.S.C. §112**

Claims 1, 3-4 and 6 were rejected under 35 U.S.C. §112, first paragraph.

This rejection is traversed at least for the following reasons.

*The Office Action contends that for the claim 1 term of “in close proximity” lacks written description.*

In response to this contention, “the purpose of the ‘written description’ requirement is broader than to merely explain how to ‘make and use’; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). See also M.P.E.P 2163.02.

“The applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed.” *In re Alton*, 37 USPQ2d 1578, 1581 (Fed. Cir. 1996). “Drawings alone may be sufficient to provide the ‘written description of the invention’ required by §112, first paragraph.” *Vas-Cath Inc. v. Mahurkar*, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

Claim 1 provides that said mark portion includes a first cavity and a second cavity disposed *in close proximity* to the first cavity, each one of the first and second cavities extending into a depth direction of the tread surface. In this regard, at least figures 5(a) to 5(d) and figures 6(a) and 6(b) and their associated descriptions show an example of a pneumatic tire, wherein a thin groove 3 that extends along the width direction of the tire and another thin groove 4 that extends along the circumferential direction X of the tire are *closely placed* on the tread surface 1. Also note figures 10(a) to 10(d) and 12(a) to 12 (d) and their associated descriptions for additional support.

Nevertheless, while not conceding the propriety of the rejection and in order to advance the prosecution of the above-identified application, claim 1 has been amended.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Claims 1, 3-4 and 6 were rejected under 35 U.S.C. §112, second paragraph.

This rejection is traversed at least for the following reasons.

*The Office Action contends that for the claim 1 term of “in close proximity” lacks clarity.*

In response to this contention, “a patentee can be his own lexicographer provided the patentee's definition, to the extent it differs from the conventional definition, is clearly set forth in the specification.” *Beachcombers v. Wildewood Creative Prods., Inc.*, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994).

“For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims.” *General Electric Co. v. Nintendo Co.*, 50 USPQ2d 1910, 1914 (Fed. Cir. 1999).

The claim language “is not construed in a lexicographic vacuum, but in the context of the specification and drawings.” *Toro Co. v. White Consolidated Industries Inc.*, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999).

Claim 1 provides that said mark portion includes a first cavity and a second cavity disposed in close proximity to the first cavity, each one of the first and second cavities extending into a depth direction of the tread surface. In this regard, at least figures 5(a) to 5(d) and figures 6(a) and 6(b) and their associated descriptions show an example of a pneumatic tire, wherein a thin groove 3 that extends along the width direction of the tire and another thin groove 4 that extends along the circumferential direction X of the tire are closely placed on the tread surface 1. Also note figures 10(a) to 10(d) and 12(a) to 12 (d) and their associated descriptions for additional support.

However, while not conceding the propriety of the rejection and in order to advance the prosecution of the above-identified application, claim 1 has been amended.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

**Rejections under 35 U.S.C. §102 and §103**

Claims 1, 3, 4 and 6 were also rejected under 35 U.S.C. §103 as allegedly being obvious over U.S. Patent No. 4,226,274 to Awaya et al. (Awaya) in view of U.S. Patent No. 2,261,025 to Havens.

This rejection is traversed, at least for the following reasons.

Awaya arguably teaches a pneumatic tire 11 that includes a mark portion 21 of a wear indicator which changes as wear progresses (Awaya at figures 2-4). The mark portion 21 is arguably provided on a portion of a tread surface of tire 11 and disposed apart and in isolation from a main groove 13 extending circumferentially about the tire (Awaya at figure 3). Awaya arguably teaches the mark portion 21 as having a first cavity (Awaya at figures 2 and 4).

Yet, Awaya fails to disclose, teach or suggest the mark portion 21 having a second cavity abutting the first cavity.

Moreover, Awaya fails to disclose, teach or suggest the first cavity having a first surface shape defining a first surface area that *continuously changes* as a depth of the tread surface decreases due to wear and the second cavity having a second surface shape defining a second surface area that *remains constant* as the depth of the tread surface decreases due to wear.

These points have been previously set forth within the Remarks section of the Amendment filed on May 24, 2004.

Thus, Awaya fails to disclose, teach or suggest a tire wherein the mark portion includes a first cavity and a second cavity abutting the first cavity, each one of the first and second cavities extending into a depth direction of the tread surface, and wherein the first cavity

has a first surface shape defining a first surface area that continuously changes as a depth of the tread surface decreases due to wear and the second cavity has a second surface shape defining a second surface area that remains constant as the depth of the tread surface decreases due to wear.

The Office Action acknowledges the absence within Awaya of a second cavity disposed in close proximity to the first cavity (Office Action at page 4), and cites Havens for the features deficient within Awaya.

Havens arguably teaches a pneumatic tire having improved traction and antiskid characteristics (Havens at page 1, first column, lines 1-4). While Havens arguably teaches the presence of main groove 3 extending circumferentially about the tire, arguably teaches notches 5, and arguably teaches slits 6 (Havens at figures 1, 2, and 3), neither notches 5 nor slits 6 of Havens is a mark portion of a wear indicator. Instead, notches 5 and slits 6 of Havens arguably are used in forming an antiskid element.

Moreover, Havens fails to disclose, teach or suggest notches 5 being disposed apart and in isolation from the main groove 3. Havens additionally fails to disclose, teach or suggest slits 6 as having a first cavity and a second cavity abutting the first cavity.

Havens also fails to disclose, teach or suggest a first cavity having a first surface shape defining a first surface area that *continuously changes* as a depth of the tread surface decreases due to wear and a second cavity has a second surface shape defining a second surface area that *remains constant* as the depth of the tread surface decreases due to wear.

These points have been previously set forth within the Remarks section of the Amendment filed on May 24, 2004.

Like Awaya, Havens also fails to disclose, teach or suggest a tire wherein the mark portion includes a first cavity and a second cavity abutting the first cavity, each one of the first and second cavities extending into a depth direction of the tread surface, and wherein the first cavity has a first surface shape defining a first surface area that continuously changes as a depth of the tread surface decreases due to wear and the second cavity has a second surface shape

defining a second surface area that remains constant as the depth of the tread surface decreases due to wear.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Claim 1 was rejected under 35 U.S.C. §102 as allegedly being anticipated by British Patent Specification No. 546,975 (GB 546,975).

Claims 3, 4 and 6 were also rejected under 35 U.S.C. §103 as allegedly being obvious over GB 546,975 in view of U.S. Patent No. 3,833,040 to Bins.

These rejections are traversed at least for the following reasons.

GB 546,975 arguably teaches a pneumatic tire having main groove 4 extending circumferentially about the tire (GB 546,975 at page 3, lines 107-108 and 116-117).

However, GB 546,975 fails to disclose, teach or suggest a mark portion of a wear indicator which changes as wear progresses.

The Office Action contends that the holes found within GB 546,975 are the claimed mark portions. Figure 5 of GB 546,975 arguably depicts a hole having a first cavity 5 and a second cavity 5 interconnected below the surface of the tire tread 11 (GB 546,975 at page 4, lines 57-61).

But note, GB 546,975 fails to disclose, teach or suggest the first cavity 5 having a first surface shape defining a first surface area that *continuously changes* as a depth of the tread surface decreases due to wear and the second cavity 5 having a second surface shape defining a second surface area that *remains constant* as the depth of the tread surface decreases due to wear.

In addition, the Office Action admits that GB 546,975 does not teach a method of determining tread wear by using the hole having a constant cross-sectional shape as a reference (Office Action at page 6).

Thus, GB 546,975 fails to disclose, teach or suggest a tire wherein the mark portion includes a first cavity and a second cavity abutting the first cavity, each one of the first and second cavities extending into a depth direction of the tread surface, and wherein the first cavity has a first surface shape defining a first surface area that continuously changes as a depth of the tread surface decreases due to wear and the second cavity has a second surface shape defining a second surface area that remains constant as the depth of the tread surface decreases due to wear.

The Office Action cites Bins for the features deficient within GB 546,975. Bins arguably teaches grooves 3 and 4 (Bins at figures 1-2). On the tread 2 and grooves 3 and 4 of Bins there is a thin layer of material 5 of a different color (Bins at column 2, lines 40-43). Bins arguably teaches grooves 7 deeper than grooves 8 (Bins at figures 3-6, column 2, lines 61-66). Bins arguably teaches shallow transverse grooves 9 and deeper V-grooves 10 (Bins at figures 7-8, column 3, lines 4-8).

However, Bins fails to disclose, teach or suggest a first cavity having a first surface shape defining a first surface area that *continuously changes* as a depth of the tread surface decreases due to wear and a second cavity has a second surface shape defining a second surface area that *remains constant* as the depth of the tread surface decreases due to wear.

Like GB 546,975, Bins also fails to disclose, teach or suggest a tire wherein the mark portion includes a first cavity and a second cavity abutting the first cavity, each one of the first and second cavities extending into a depth direction of the tread surface, and wherein the first cavity has a first surface shape defining a first surface area that continuously changes as a depth of the tread surface decreases due to wear and the second cavity has a second surface shape defining a second surface area that remains constant as the depth of the tread surface decreases due to wear.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

**Conclusion**



For the foregoing reasons, all the claims now pending in the present application are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of the amendments and remarks is courteously solicited.

If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone Brian K. Dutton, Reg. No. 47,255, at 202-955-8753.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: October 20, 2004

Respectfully submitted,

By  

David T. Nikaido

Registration No.: 22,663

Brian K. Dutton

Registration No.: 47,255

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorneys for Applicant